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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,091	08/06/2003	Anne M. Pianca	20334/0209347-US0	6980

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Boston Scientific Neuromodulation Corp.
c/o DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
NEW YORK, NY 10008-0770

EXAMINER

KAHELIN, MICHAEL WILLIAM

ART UNIT	PAPER NUMBER
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3762

MAIL DATE	DELIVERY MODE
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10/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/635,091

Applicant(s)

PIANCA ET AL.

Examiner

MICHAEL KAHELIN

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 5-10, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Noone et al. (US 5,916,178, hereinafter "Noone").

3. In regards to claim 1, Noone discloses a stylet having an outer covering that is a tube made of metal material and being constructed to have a solid annular lateral cross-section (Fig. 1 and col. 3, lines 31-36); and a solid inner core inside the outer covering and having a solid lateral cross-section (Fig. 1, and col. 4, lines 9-15), wherein the outer covering material and inner core material have different elastic and buckling properties (col. 3, lines 33-36 and col. 4, line 10).

4. In regards to claim 2, the outer material is nitinol and the inner core is stainless steel (col. 3, lines 33-36 and col. 4, line 10), which are disclosed by Applicant as possessing the claimed properties.

5. In regards to claims 5 and 6, the stylet is isodiametric and the inner core has a variable diameter (Fig. 1).

6. In regards to claim 7, the outer covering has a substantially constant wall thickness along the length of the stylet (Fig. 1, the portion distal to taper 60).
7. In regards to claim 8, the stylet has a variable outer circumference along the length of the stylet (the distal tip's circumference varies - the claim language does not require the circumference to vary along the entire length of the stylet).
8. In regards to claim 9, the outer covering has a substantially constant wall thickness along the length of the stylet (portion distal to taper 60).
9. In regards to claim 10, the inner core has a substantially constant thickness along the length of the stylet (65).
10. In regards to claim 22, the inner core increases in diameter from the proximal end to the distal end (80).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 3, 4, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noone in view of Reynolds et al. (US 7,074,197, hereinafter "Reynolds"). Noone discloses the essential features of the claimed invention including a preformed rod made of stainless steel (col. 4, lines 9-39), but does not expressly disclose that the stainless steel is one of the claimed alloys; an inner core made of nitinol; outer covering made of the claimed stainless steel alloys; or an inner core that that has been pre-stressed to operate on the compression side of the stress-strain curve. Reynolds teaches a means for attaching two different metals of a composite stylet structure (Fig. 2) comprising an inner core made of nitinol (26; col. 3, lines 51-60); outer covering made of the claimed stainless steel alloys (combined structure of 24 and 18; col. 3, line 44); and an inner core that that has been pre-stressed to operate on the compression side of the stress-strain curve (col. 4, lines 3-29) to provide the predictable result of providing the desired mechanical characteristics for "pushability" through the tortuous anatomy. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Noone's invention by providing a stylet having an inner core made of nitinol, outer covering made of the claimed stainless steel alloys, and an inner core that that has been pre-stressed to operate on the compression side of the stress-strain curve to provide the predictable result of providing the desired mechanical characteristics for "pushability" through the tortuous anatomy.

Response to Arguments

14. Applicant's arguments with respect to claims 1-13 and 22 have been considered but are moot in view of the new ground(s) of rejection, necessitated by amendment.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL KAHRELIN** whose telephone number is (571)272-8688. The examiner can normally be reached on M-F, 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Kahelin/
Examiner, Art Unit 3762

/Angela D Sykes/
Supervisory Patent Examiner, Art Unit 3762